

REMARKS

Claims 1-7 are pending in the present application, and stand rejected. Reconsideration and allowance of the claims are respectfully requested in view of the following remarks.

Claims 1-7 stand rejected under 35 U.S. C. § 103(a) as being unpatentable over Frank et al (U.S. Patent No. 5,698,019) or German Patent No. 1 441 336 in view of Chemical Abstracts 120 (M.Y. Shareef et al.).

In making the rejections over Frank et al, the Examiner states that Frank discloses a material with components which overlap the claimed components. Second, the Examiner states that, due to this overlap, the claimed maturing temperatures and coefficients of thermal expansion would be inherent in the materials of Frank. Third, the Examiner states that Applicant's claims regarding leucite crystals "not exceeding 10 microns" is rendered obvious by Frank because Frank discloses an average crystal size of 3 microns and, in addition, teaches "that it is advantageous for mechanical strength if 'all the crystals of the individual phases are essentially of the same size.'" (Office Action, p.2).

Respectfully, the Examiner's obviousness rejection is improper because Frank fails to render obvious all elements of Applicant's claims. *See In Re Wilson*, 165 U.S.P.Q. 494, 496 (C.C.P.A. 1970) (Establishing a prima facie case of obviousness requires that all elements of the invention be disclosed in the prior art). Frank cannot render obvious Applicant's claims to an absolute crystal size of less than 10 microns because Frank provides no teaching to one of skill in the art how to obtain an absolute crystal size of less than 10 microns.¹ "In order to render a claimed apparatus or method obvious, the prior art must enable one skilled in the art to make and use the apparatus or method." *Beckman Instruments, Inc. v. LKB Produkter AB*,

¹ In contrast, the present Application provides detailed teaching on how to obtain an absolute crystal size of less than 10 microns. *See* Application, p. 9, ll. 5-22.

892 F.2d 1547, 1551, 13 USPQ2d 1301, 1304 (Fed.Cir.1989) (emphasis added). Thus, because Frank is non-enabling as to an absolute crystal size of less than 10 microns, Frank cannot render the Applicant's claims obvious.

For the same reasons, the Examiner's obviousness rejection under German Patent No. 1 441 336 in view of Shareef et al is improper. In making the rejection, the Examiner states that German Patent No. 1 441 336 discloses Applicant's claimed dental porcelain "with the exception of the claimed limitation 'diameters not exceeding about 10 microns.'" (Office Action, p. 3). The Examiner further states that Shareef teaches that "leucite crystals having a more uniform distribution and finer size" are desirable. *Id.* However, as with Frank et al, neither German Patent No. 1 441 336 nor Shareef enable one of skill in the art to obtain leucite crystals with an absolute crystal size of less than 10 microns in a dental porcelain. Accordingly, under *Beckman Instruments, supra*, Applicant's invention cannot be rendered obvious by German Patent No. 1 441 336 in view of Shareef et al.

It has been shown that the neither Frank reference, nor German Patent No. 1 441 336 in view of Shareef enable leucite crystals less than 10 micron diameter, an element of independent claim 1, and therefore cannot render claim 1 obvious. If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988). Therefore, dependent Claims 2-7 are nonobvious as well.

For the reasons discussed above, Applicants respectfully submit that Applicants' Claims 1-7 patentably distinguish over Frank. Therefore, Applicants request that the Examiner now reconsider and withdraw the rejections of Claims 1-7 under 35 U.S.C. 103(a) as being unpatentable.

With respect to the Examiner's request for additional information regarding resolution of the dispute regarding evidence in the current litigation entitled Jeneric/Pentron Inc. v. Dillon Company, Inc. and Chemichl, Inc., Applicant refers the Examiner to the Information Disclosure Statement which accompanies this Response.² Jeneric/Pentron recently prevailed at the trial court level when the district court granted its motion for sanctions in a Ruling dated February 27, 2003. In its Ruling, the district court struck the Defendants' affirmative defense of public use, thus resolving the issue of public use (and on-sale) activity in Jeneric/Pentron's favor. It is anticipated that the Defendants will appeal the district court's Ruling to the Federal Circuit, a process that will take about a year or so. A detailed status report on the litigation is provided below.

Jeneric/Pentron filed the litigation alleging infringement of its U.S. Patent No. 5,653,791 ("hereinafter '791 Patent") and, subsequently, its U.S. Patent No. 5,944,884 ("the '884 Patent"), which is a continuation of a divisional application of the '791 Patent (as is the present application). The Defendants to the litigation asserted invalidity of the '791 Patent and '884 Patent based on, *inter alia*, an alleged prior public use of a material known as "LF-1-PFM." In August of 2001, the district court issued its decision on the parties' cross-motions for summary judgment. Specifically, the district court denied the Defendants' motions for summary judgment of non-infringement and invalidity of the asserted patents. The court also denied the Defendants' motion for summary judgment that the '884 Patent is unenforceable due to inequitable conduct before the Patent and Trademark Office. Moreover, the court denied Plaintiff's motion for summary judgment of infringement of the '884 Patent.

² Applicant filed trial materials dated from September 3, 1998 through October 7, 2002 with the Examiner in an IDS filed October 17, 2002 in connection with related and co-pending Application No. 09/634,476. Rather than inundate Examiner with second identical copy of the voluminous materials, Applicant refers Examiner to the IDS of October 17, 2002 and files a separate IDS with trial materials generated since October 7, 2002 herewith.

Following the summary judgment decision, a bench trial was held on the issue of alleged inequitable conduct on May 13-14, 2002, and a jury trial was held on May 20-24, 2002 on the issues of infringement and patent validity. The judge found that no inequitable conduct had been committed. In addition, the jury found the accused porcelain products to infringe the asserted claims. Further, the jury found that the LF-1-PFM was in public use more than one year prior to the filing date of the '791 Patent and therefore anticipated the '791 Patent and '884 Patent.

After the jury verdict, several cross-motions for judgment as a matter of law were filed by both parties, including, *inter alia*, Plaintiff's motion for judgment as a matter of law that the LF-1-PFM material was not in public use prior to the filing date of the '791 Patent and therefore did not anticipate the asserted patents. In a ruling issued in September 2002, the Court denied all motions for judgment as a matter of law.

During the jury trial, certain critical evidence relating to the crystal size of the LF-1-PFM material prior to the critical date surfaced for the first time. More specifically, the Defendants produced micrographs of the LF-1-PFM material that predated any other micrographs previously produced. The Court excluded the micrographs from evidence during trial but allowed the Plaintiff's motion for post-trial discovery relating to the previously undisclosed evidence.

Pursuant to the post-trial discovery, substantial additional evidence relating to the crystal structure of the LF-1-PFM material prior to the critical date was discovered. Plaintiff therefore filed a motion for new trial as well as a motion to strike the Defendant's affirmative defense of public use in light of the failure to disclose the evidence relating to microstructure.

As mentioned above, the district court granted Plaintiff's motion for sanctions and struck the Defendant's affirmative defense of public use. In its Ruling, the district court found that "the new evidence would probably result in a different outcome" if it had been available to Plaintiff prior to trial. Ruling, p.16. Thus, Jeneric/Pentron's '791 patent and '884 patent stand as valid. The Defendants have not yet filed a notice of appeal but have indicated that they will shortly.

It is believed that the foregoing remarks fully comply with the Office Action and that the claims herein should now be allowable to Applicants. Accordingly, reconsideration and allowance are requested.

If there are any additional charges with respect to this Response or otherwise, please charge them to Deposit Account No. 06-1130 maintained by Applicants' Attorneys.

Respectfully submitted,

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